

REMARKS/ARGUMENTS**1.) Claim Status:**

Claims 1, 15, and 40-41 have been amended.

Claim 39 has been canceled without prejudice.

Claims 1-38, and 40-41 are pending.

During the Examiner's review of the file, the Examiner noticed that an incorrect version of the claims was submitted with the last response, dated April 22, 2004. The Examiner called the Applicant's attorney to discuss this mistake and directed the rejections to the correct set of claims. The Applicant appreciates the Examiner's thorough review of the claims and apologizes for any confusion this may have caused.

2.) Claim Rejection - 35 U.S.C. § 112

The Examiner rejected claim 41 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement because claim 41 contains the term "plurality of sessions". Solely in order to expedite early allowance of this Application, the Applicant has amended claim 41 without prejudice to address the Examiner's concerns. Support for this amendment may be found throughout the specification, specifically on page 2, lines 22 through 24.

3. Claim Rejections – 35 U.S.C. § 102

The Examiner rejected claims 1-28, 31-34, 38 and 40-41 under 35 U.S.C. § 102(e) as being anticipated unpatentable over Lintulampi (US 6,377,804). The Applicant has amended the claims to clarify the scope of the invention. Support for this amendment may be found on page 7 lines 12 -23 of the specification. To the extent that this rejection is still maintained in light of the amendments, the Applicant respectfully traverses this rejection.

For instance, claim 1 recites:

1. A communication system comprising:
a Universal Mobile Telecommunications System (UMTS)
wherein the UMTS network is capable of handling a first number of
simultaneous communications between a mobile user equipment ,

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a Global System for a Mobile Communication System (GSM) networks, wherein the GSM network is capable of handling a second number of simultaneous communications between the mobile user equipment and the GSM network, and

wherein at least one of the mobile user equipment and the communication system contain

at least one means for evaluating if a handover between the UMTS material and GSM material should be effectuated and

at least one means for selecting, in the case that the handover is necessary, which communication or communications are handed over and

at least one means for executing the at least one decision.

The PTO provides in MPEP section 2131 that

"[t]o anticipate a claim, the reference must teach every element of the claim...."

Therefore, with respect to claim 1, to sustain this rejection the Lintulampi patent must contain all of the above claimed elements of the claim. However, contrary to the examiner's position that all elements are disclosed in the Lintulampi reference, the latter reference does not disclose: (1) UMTS network is capable of handling a first number of simultaneous communications between a mobile user equipment, (2) GSM network is capable of handling a second number of simultaneous communications between the mobile user equipment and the GSM network; (3) means for selecting, in the case that the handover is necessary, which communication or communications are handed over; and (4) a means for executing the at least one decision.

Admittedly, Lintulampi discloses a system comprising a UMTS and a GSM network. However, there is nothing in Lintulampi that indicates the UMTS or GSM networks are capable of handling a plurality of simultaneous communications with the mobile user equipment.

Lintulampi also fails to disclose a means for selecting which communication or communications are to be handed over. The examiner states that this means can be found in Lintulampi at col. 4, lines 40 to 64. In fact, the given reference (col.4 lines 40-64) emphasizes the difference between claim 1 and disclosure of Lintulampi. Note that claim 1 is all present tense, which means that the communications in claim 1 are

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on-going communications. This is in contrast to Lintulampi, where the requested service is not set up, so there is no on-going communication to hand over.

Lintulampi describes a terminal that requests a service. Note that at the requesting stage, the service is not yet provided so there is no plurality of communications¹ (col. 4 lines 44-45). As the service cannot be provided in the GSM network, the terminal is handed over (in fact it roams to) to the UMTS network (col. 4 lines 48 to 51). At this point, one skilled in the art would recognize that the terminal has no active connection or communication because the service it requests cannot be provided by its current network. In fact, Lintulampi changes the network from GSM to UMTS, which is an increase in capabilities, whereas the invented system handles the case of a change from UMTS to GSM, with a decrease of capabilities.

Therefore Lintulampi does not have the problem to select which ongoing communications are to be handed over because: (1) Lintulampi's system hands over at a point in time where no communication is ongoing, and (2) the "handover" is performed from GSM to UMTS where all connections could be kept alive and active. Thus Lintulampi simply does not have, nor would have a reason to disclose a means for selecting which communication or communications are handed over.

Additionally, as Lintulampi does not disclose the means for selecting, it also does not disclose means for executing the at least one decision.

Therefore, the § 102 rejection is simply not supported by the Lintulampi reference and should be withdrawn.

Independent claims 15 and 40 are patentable for similar reasons. Consequently, the applicant respectfully requests that the § 102 for these claims be withdrawn. Claims 2-14, 16-28, 31-34, 38 and 41 depend from independent claims 1, 15, and 40 and recite further limitations in combination with the novel elements of the independent claims. Therefore, the allowance of claims 2-14, 16-28, 31-34, 38 and 41 is also respectfully requested.

¹ On page 2, lines 20-23, the Applicant's specification states: Future communication systems will allow mobile user equipments to perform a greater number of communications simultaneously. Examples of the communication include telephone calls, faxes, downloading of data or uploading of data (file transfer).

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4. Claim Rejections – 35 U.S.C. § 103(a)

The Examiner rejected claims 29-30 under 35 U.S.C. § 103 (a) as being unpatentable over Lintulampi (US 6,377,804). The Applicant respectfully traverses this rejection.

As provided in MPEP § 2143, "[t]o establish a prima facie case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." Furthermore, under MPEP § 2142, "[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness."

First, as discussed above, claims 29 and 30 incorporate the limitations of claim 15. As discussed above, Claim 15 contains elements which are not found in Lintulampi (e.g., the step of selecting which communication or communications are handed over). Thus, claims 29 and 30 are patentable for this reason, alone. Second, the examiner admits that Lintulampi does not teach all of the elements of claims, however, the examiner has taken "official notice" of limitations admittedly not found in Lintulampi.

As the examiner is aware, the Applicant must traverse the use of Official Notice or waive his right to object in future responses. Consequently, the Applicant traverses the examiners use of Official Notice. Under MPEP § 2144.03, official notice may only be taken of "facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art." When a rejection is based on facts within the personal knowledge of the Examiner, the facts must be as specific as possible, and the reference must be supported, when called for by the applicant, by an affidavit of the Examiner, which may be subject to explanation by the Applicant. See also 37 CFR 1.104(d)(2). Pursuant to 37 CFR 1.104(d)(2), the Applicant respectfully requests the Examiner provide such supporting facts and evidence in the form of an affidavit, so that, if necessary, the Applicant may explain the reference.

The Examiner rejected claims 35-37 and 39 under 35 U.S.C. § 103 (a) as being unpatentable over Lintulampi (US 6,377,804) in view of Byrne (US 5,737,703). Solely in order to expedite the allowance of this application, the Applicant has canceled claim 39. With respect to claims 35 and 37, the Applicant also traverses this rejection.

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As provided in MPEP § 2143, "[t]o establish a prima facie case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." Furthermore, under MPEP § 2142, "[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness."

As discussed above, claims 35-37 incorporate the limitations of claim 15. As discussed above, Claim 15 contains elements which are not found in Lintulampi (e.g., the step of selecting which communication or communications are handed over). The Applicant incorporates by reference its earlier discussion regarding why Lintulampi does not teach nor disclose the step of selecting which communication or communications are handed over. Additionally, the Applicant respectfully submits that Byrne does not provide the missing claim limitations as discussed above. Byrne appears to deal with handing a *single* call over from one system to another. Consequently, there is not selection among which communications would be handed over. Thus, the office action does not factually support a prima facie case of obviousness for claim 11 based on the combination of Lintulampi and Byrne. The Applicant, therefore, respectfully requests that this rejection be withdrawn.

CONCLUSION

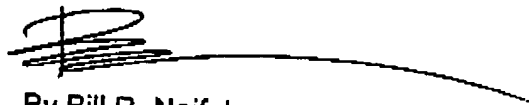
In view of the foregoing remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for all pending claims.

The Applicant requests a telephonic interview with the Examiner if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

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Respectfully submitted,



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